

48. The system of claim 47, further comprising:

a sponsor computer coupled to the network operative to allow a sponsor of one of said incentive programs to designate said geographic location of redemption by said consumer user of said award.

a3
cancel

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-17, 33, 34, and 39-48 will be pending in the application, with claims 1, 3, 6, 11, 33 and 34 being the independent claims. Claims 18-32 and 35-38 are cancelled without any prejudice or disclaimer. New claims 39-48 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

If any portion of the specification or claims were sought to be amended in the foregoing, attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Based on the above Amendment and the following Remarks, Applicant traverses the rejections and respectfully requests that the Examiner reconsider all outstanding rejections or objections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

The Examiner at ¶¶ 1 and 2 rejects claims 1-3, 6, 10-15 and 17 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,774,870 (hereafter "Storey"), and 27-32 as being anticipated by U.S. Patent Application 5,855,008 (hereafter "Goldhaber"), respectively. Applicant traverses the rejection. The present invention differs in several important ways from the Storey reference. The Examiner's rejection of claims 27-32 are rendered moot by the above amendment.

Storey is apparently directed to a "fully integrated on-line frequency award program" such as a frequent flier program. The Storey frequency award program allows a consumer user from a web browser to browse an online catalog of awards to select from a preset list of awards to electronically place an order to redeem a ***consumer user designated award*** corresponding to an amount of awarded points. Fulfillment of the award itself is performed manually using a conventional "***fulfillment house***". See Abstract, for example.

The claimed invention, by comparison, sets forth systems and methods for generating an incentive program (such as the program described in Storey) and for providing automated award fulfillment. Unlike Storey which deals with the management of an existing promotional

program, the claimed invention is used to *generate new incentive programs* that provide for *automated award fulfillment*. Automated award fulfillment, according to the present invention, *includes sponsor designated redemption* whereby the sponsor of the award may designate what award will be provided to the consumer user, and may designate the location of the redemption. For example, the location may include the geographical location of the retailer, merchant or point of sale (POS). Moreover, the present invention coordinates the delivery of the award or, alternatively, arranges for retrieval of awards in volumes that permit successful incentive fulfillment programs. Storey, by comparison, describes consumer user designated selection of an award and how to redeem the award and then a manual fulfillment house arranges to deliver the award to the consumer user.

Regarding claims 1 and 3, the Examiner asserts that all elements of claims 1 and 3, are anticipated by Storey. Applicant disagrees. As amended, the “automated award fulfillment application” feature of claims 1 and 3 is not taught or suggested by Storey. Specifically, unlike Storey, which has the consumer select an award (col. 1, lines 23-25) and merely shifts actual fulfillment to a “fulfillment house” or “directly to a product manufacturer” (col. 10, lines 4 and 5), the claimed invention provides automated award fulfillment, by which, as detailed in the specification, a sponsor of a program designates what award will be provided and the location for redemption by the consumer user. A very detailed overview of retail fulfillment is described in the specification beginning on page 92, line 13 and on page 97, lines 15-20, page 99, line 4 through page 100, line 5. Thus, claims 1 and 3 are patentable over Storey.

For at least the reasons described above relating to claims 1 and 3, claims 2 and 4, and new claims 39-48, are also patentable. Moreover, new claims 39-48 claim additional features not taught or suggested by Storey.

In similar fashion to claims 1 and 3, independent claims 6, as amended, and claim 11 are clearly directed to automated award fulfillment systems. For at least the reasons above with respect to claims 1 and 3, claims 6 and 11 are patentable. Moreover, applicants disagree with the Examiner's assertion that col. 7 line 45 to col. 8 line 54 from Storey teach anything related to automatic award fulfillment in the sense used in the present invention. Indeed, Storey teaches away from the type of automatic award fulfillment of the present invention. Storey facilitates flexibility and ease for the *consumer user* regarding the selection and fulfillment of awards, while *the present invention gives such flexibility and ease to the sponsor of the award*, rather than the consumer. Thus, Storey and the present invention have opposing and mutually exclusive goals.

The Examiner's rejections of claims 27-30 in ¶¶ 4 and 5 of the Office Action are rendered moot by the above amendment. For at least the reasons discussed above regarding the independent claims, the dependent claims 2, 10, 21-15, and 17 are patentable over Storey.

Rejections under 35 U.S.C. § 103

The Examiner at ¶3 rejects claims 1-23, and 33-34 under 35 U.S.C. §103(a) as being obvious in view of Storey. Applicant traverses the rejection.

For at least the reasons discussed above, independent claims 1, 3, 6, 11, 33 and 34 are patentable over Storey.

For at least the reasons described above, with reference to independent claims 1, 3, 6 and 11, it follows that dependent claims 2, 4, 5, 7-10, and 12-17, as amended, are also patentable over Storey.

The Examiner's rejections of claims 18-23 at ¶¶ 5 of the Office Action are rendered moot by the above amendments.

The Examiner's rejections of claims 31-32, 24-26, 35 and 37, 36 and 38 at ¶¶ 6, 7 and 8 of the Office Action are rendered moot by the above amendments.

The Examiner at ¶ 9 of the Office Action rejects claims 33 and 34 under 35 U.S.C. §103(a) as being unpatentable over Storey in view of Goldhaber. Applicant traverses the rejection. The applied references, alone or in combination, do not teach or suggest all the features of the claimed invention.

For at least the reasons described above, with reference to independent claims 1, 3, 6 and 11, Applicant asserts that claims 33 and 34 are also patentable over Storey and Goldhaber, alone or in combination.

Regarding claim 33 and 34, as noted above, the "automatic fulfillment" of the present invention goes beyond the type of award fulfillment contemplated and taught by Storey. There are fundamental differences between the present invention and Storey. First, the present invention allows far more flexibility for the sponsor of the incentive program to design his award

fulfillment program. Second, the present invention actually contradicts Storey in that the purpose of Storey is to provide convenience to the consumers, while the object of the present invention is to provide convenience to the sponsor. After the designation of the particular award, Storey merely delegates the actual delivery to a "fulfillment house," whereas the present invention allows the sponsor to coordinate the delivery of the award, or, alternatively, to designate to the consumer where the award may be retrieved. The addition of Goldhaber does not suggest or teach these fundamental differences.

Goldhaber is directed to compensating a consumer for paying attention to certain advertisements. As with Storey, Goldhaber does not go beyond consumer selection of an award. The actual coordination of delivery of the award is not taught or suggested in this patent. Moreover, the combination of Goldhaber does not provide motivation to combine itself with Storey.

The Examiner rejects in ¶ 9 claims 33 and 34 based on his argument of claims 18 and 22 on page 5 and 6 of the Office Action. In this argument the examiner concedes that Storey does not teach or suggest a sponsor. Applicant disagrees that it would have been obvious to include a sponsor, especially in light of the opposing objects of the two inventions (i.e. Storey is directed to providing ease and flexibility to the customer, while the present invention is directed to providing ease and flexibility to the sponsor of the incentive program).

The Examiner also concedes on page 10 of the office action that a fulfillment application program for associating a fulfillment method is not taught by Goldhaber. Applicant agrees. The

Examiner then asserts that Storey discloses such an fulfillment application program. However, as noted above, the present invention contemplates a different meaning of "award fulfillment." Furthermore, the Examiner asserts that it would have been obvious to combine the references based on an alleged motivation of maintaining an account of the users balance and transactions. Applicant disagrees. The patents are directed to totally different applications and Applicant submits that the examiner has not shown an proper motivation to combine.

Furthermore, consideration of the other applied reference U.S. Patent 5,699,310 (hereafter "Garloff") adds nothing, such that Garloff, Storey and Goldhaber, alone or in combination, also do not teach or suggest all the features of the claimed invention.

Thus all previously pending claims 1-17, 33 and 34 are patentable over the applied references. For at least the above reasons, new claims 39-44 are also patentable over the applied references.

Improper Combination of References

Applicant further respectfully points out that the Examiner has not proven his prima facie case of obviousness. As discussed above, the Storey, Goldhaber and Garloff references, alone or in any combination with one another, do not teach or suggest all of the features of the claimed invention. Further, the Examiner has improperly combined the references. The Examiner has not shown a proper motivation to combine the references to allegedly obtain the claimed invention. The Examiner is using hindsight to combine the references based on the Applicant's

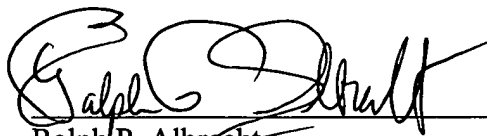
Specification. The Examiner must teach a motivation to combine the references to properly prove his prima facie case of obviousness.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



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Version with markings to show changes made

1. A system for incentive program generation and automated award fulfillment, comprising:
 - a host computer ~~connected~~ coupled to a network;
 - a database accessible from said ~~of such~~ host computer; and
 - an automated award fulfillment application program executable on said host computer for participation in incentive programs of a plurality of ~~independent~~ providers.

2. The system of claim 1, further comprising:
 - a client computer of a consumer user coupled to the network;
 - a server coupled to said ~~of the~~ host computer; and
 - a browser executing on said client computer operative to access content ~~web site~~;located on said ~~the~~ server ~~the host computer~~
_____ wherein the consumer user ~~may~~ participates in said incentive programs of the plurality of ~~independent~~ providers via the ~~web~~ site interaction with said browser.

3. A method for generating incentive programs and automating award fulfillment, comprising:

providing a host computer, the host computer having a database and an automated award fulfillment application program;

automating award fulfillment; and

permitting access to ~~said~~the database via a ~~computer network~~, ~~wherein a~~ including allowing participant in said system may participation in incentive programs of a plurality of providers. ~~via the application program.~~

4. The method of claim 3, further comprising:

providing a ~~computer network having a first and a second~~ coupling said host computer to a workstation and being capable of transferring electronic data between ~~said~~the workstations and said, ~~wherein the first workstation is the~~ host computer;

providing each of said host computer and saidthe workstations with an application program capable of responding to input from ~~the first workstation~~ said host computer or the second said workstation;

allowing a user of said ~~at the host computer~~ first workstation to operate said automated award fulfillment ~~the~~ application program to generate an incentive program and to that is stored as an electronic file ~~said incentive program on the first workstation~~ said host computer;

transferring a stored incentive program ~~the electronic file to said~~ the second workstation; and

providing an address for said stored incentive programs~~such file~~ to permit access to said stored incentive program ~~such file~~ from said a computer network.

5. The method of claim 4, further comprising:

providing at least one of an award association application program that associates an award-prize with said an incentive program, and an award fulfillment association application program that associates a fulfillment option with an award-prize.

6. A system for automating award fulfillment, comprising:

a network;

a host computer, coupledeconnected to ~~the~~said network;

a database of saidthe host computer;

an browser operative to browse content-application program of ~~the~~said host computer, wherein a consumer user-participant may participates in an incentive program;

an awards database of awards associated with saidthe incentive program; and

an automated award fulfillment application program for automating fulfillment of awards for saidthe incentive program.

7. The system of claim 6, further comprising:

a card for fulfillment of awards won in saidthe incentive program.

8. The system of claim 7, ~~wherein the card comprises~~ 6, further comprising:
a memory for operative to storing at least a personal identification number
associated with a consumer user.
9. The system of claim 8, ~~wherein the card~~ 6, further comprising:
memory for storing information relating to ~~a user's participation of said consumer~~
user in an incentive program.
10. The system of claim 6, further comprising:
a browser website, coupled to located on said the host computer, wherein said the
consumer user may participates in incentive programs of at least two providers via the
~~web site~~ said browser.
11. A method for generating incentive programs and automating award fulfillment,
comprising:
providing a host computer;
providing an incentive program on the host computer, wherein a participant may
participate in an incentive program;

providing a database of awards on the host computer associated with the incentive program; and

providing automated fulfillment of such awards to participants.

12. The method of claim 11, wherein said the database of awards includes awards from a plurality of sponsors.

13. The method of claim 11, wherein said providing automated fulfillment step comprises:

associating an award with the incentive program; and

associating a fulfillment method with the award.

14. The method of claim 11, wherein said providing automated fulfillment step further comprises:

providing a card comprising memory for storing data associated with a user.

15. The method of claim 13, wherein said associating a fulfillment method step comprises:

providing an optimization application program that identifies an award based on the geographic proximity of an award winner to a redemption location of an award in the database of awards.

16. The method of claim 14, wherein said~~the~~ data is a personal identification number.

17. The method of claim 14, wherein said~~the~~ data is information relating to a user's participation in an incentive program.

33. A system for building an incentive program having automated fulfillment, comprising:

a computer couplede~~connected~~ to a network;

an incentive program generation application program for generating an incentive program in response to input of parameters by a user;

an award association application program for associating an award with the incentive program; and

an automated fulfillment application program for associating a fulfillment method with said~~the~~ award.

34. A method of providing for generation of an incentive program having automated fulfillment over a ~~computer~~-network, comprising:

providing a computer coupledeconnected to a network;

generating an incentive program in response to input from a user;

associating an award with the incentive program; and

associating a fulfillment method with the award, wherein at least one of

generating an incentive program, associating an award-prize and associating a fulfillment method is accomplished by an automated fulfillment application program.

39. The system of claim 2, further comprising:

a redemption workstation associated with each of said plurality of providers coupled to the network;

at least one of

a member management database, coupled to the network, operative to add a member record for a new member. and

an inventory management system associated with each of said plurality of providers coupled to said redemption workstation; and

wherein said automated award fulfillment application program is operative to allow designation of redemption of an award including access to any inventory

management system of any of said plurality of providers and access to any member database.

40. The system of claim 39, wherein said automated award fulfillment application program is operative to select said award tailored to demographic and psychographic preferences of the consumer user stored in at least one of any of said member management databases and said database, and to allow for designation of redemption of said award at a geographic location of one of said plurality of providers.

41. The system of claim 40, further comprising:
a sponsor computer, coupled to the network, operative to allow a sponsor of one of said incentive programs to designate said geographic location of redemption by the consumer user of said award.

42. The system of claim 1, wherein said plurality of providers comprise at least one of a retailer, a merchant, and a sponsor.

43. The system of claim 2, wherein said browser comprises at least one of an internet browser, an automated teller machine, a kiosk, a gasoline pump, a wireless device, a personal digital assistant, and a communication device.

44. The system of claim 3, wherein said permitting access comprises at least one of:
providing for registration and interaction with content of said database and said
automated award fulfillment application program.

45. The system of claim 5, wherein said fulfillment options comprise:
receiving fulfillment at a sponsor designated geographic location;
receiving online fulfillment;
receiving offline fulfillment;
receiving fulfillment at a merchant;
receiving fulfillment at a retailer; and
receiving fulfillment at point of sale (POS).

46. The system of claim 6, further comprising:
a redemption computer associated with each of a plurality of providers coupled to
said network; and
at least one of:
a member database, coupled to said network, operative to add a member
record for a new member, and

an inventory management system associated with each of said plurality of providers coupled to said network; and

wherein said automated award fulfillment application program is operative to allow designation of redemption of an award including access to any inventory management system of any of said providers, access to said awards database and access to at least one of any of said member databases and said database of said host computer.

47. The system of claim 46, wherein said automated award fulfillment application program is operative to select said award tailored to any demographic and psychographic preferences known of said consumer user stored in at least one of any of said member databases, and said database of said host computer, and to allow for designation of redemption of said award at a geographic location of one of said plurality of providers.

48. The system of claim 47, further comprising:

a sponsor computer coupled to the network operative to allow a sponsor of one of said incentive programs to designate said geographic location of redemption by said consumer user of said award.